

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANTOKH S. BADESHA and
EDWARD L. SCHLUETER, JR.

Appeal 2006-1593
Application 09/737,413
Technology Center 1700

Decided: November 13, 2006

Before KIMLIN, KRATZ, and LINCK, *Administrative Patent Judges*.
KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1-21.
We have jurisdiction pursuant to 35 U.S.C. § 134.

Appellants' invention relates to a transfix member, and an image forming apparatus, such as a printing machine, that includes such a transfix component (Specification 1). According to Appellants, "a transfix or transfuse member uses heat associated with the transfer member in order to both transfer and fix or fuse the developed image to a copy substrate" (Specification 2). Appellants' transfix component device is disclosed as including a substrate or core, an optional intermediate layer and an outer layer including a delaminated nanocomposite. The delaminated nanocomposite is said to be made from a silicone elastomer and a mica-type layered silicate employed in the outer layer (Specification 7-8). Appellants provide that a heating source (member) can be associated with the transfix substrate (Specification 11). Claim 20 is illustrative and reproduced below:

20. A transfix member comprising:
- a) a transfix substrate, and thereover
 - b) a conformable intermediate layer comprising a polymeric material, and having thereon
 - c) an outer transfix layer comprising a mica-type layered silicate and silicone elastomer, said silicone elastomer and said mica-type layered silicate together forming a delaminated nanocomposite, and
 - d) a heating member associated with said transfix substrate.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Badesha '643	US 5,846,643	Dec. 8, 1998
Swift	US 6,381,436	Apr. 30, 2002
Badesha '504	US 6,482,504	Nov. 19, 2002

Claims 1-10 and 13-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Badesha '643 in view of Swift. Claims 1-17, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Badesha '643 in view of Badesha '504.

OPINION

We have reviewed Appellants' arguments for patentability and the evidence relied upon by the Examiner in asserting the obviousness of the claimed subject matter. In so doing, we find ourselves in agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 (a) in view of the applied prior art. Accordingly, we will sustain the Examiner's rejections. Our reasoning follows.

Appellants state that "Claims 1-21 stand or fall together." (Br. 4). Accordingly, we select claim 20 as the representative claim on which we shall decide this appeal. 37 CFR § 1.192(c)(7) (1997) and *In re Wood*, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

Badesha '643 discloses a device (fuser) including: (a) a core (11) that can be made of various metals; (b) an intermediate layer (22) that can be formed from a high temperature resistant elastomer, such as a silicone elastomer; and (c) an outer layer (12) made from an elastomer including a silicone elastomer and a mica-type layered silicate. The silicone elastomer and the mica-type layered silicate form a delaminated nanocomposite (Badesha '643, col. 5, l. 65 through col. 6, l. 42 and Figs. 3-5). A heating member is associated with the core of the device, which device may be in the form of a roll, plate or belt (Badesha '643, col. 6, l. 5-17).

Concerning the correspondence of the aforementioned disclosure of the device of Badesha '643 and the transfix member device required by Appellants' representative claim 20, we note that the substrate called for in claim 20 can be formed from a metal or alloys and the intermediate layer from a silicone elastomer (Specification 20). Moreover, claim 20 is open to the shape of the transfix member and Appellants provide that a variety of transfix device forms are suitable, including, *inter alia*, strip, drum, cylinder, and belt constructions (Specification 22). While Badesha '643 calls the multi-layered device disclosed therein a fuser based on the use of the device in a printing machine by Badesha '643, the structure of the fuser device of Badesha '643 corresponds with the structure recited in representative claim 20.

Whether a rejection is made under 35 U.S.C. § 103 as here, or under § 102, it is well settled that when Appellants' product and that of the prior art appear to be identical or substantially identical the burden shifts to Appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics of Appellants' claimed product. *See In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. *See Best*, 562 F.2d at 1255, 195 USPQ at 434.

In light of the above discussion, Appellants' arguments concerning a lack of suggestion and/or a lack of a reasonable expectation of success in combining either of Badesha '504 or Swift with Badesha '643 are unavailing

in that Badesha '643 alone furnishes sufficient evidence to render the representative claim 20 subject matter prima facie unpatentable. After all, a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

The thrust of Appellants' arguments, as they apply to the representative claim 20, appears to be based on the notion that the appellation "transfix member" as employed in the preamble of representative claim 20 necessarily requires a distinct structure from that disclosed by Badesha '643.¹ In this regard, Appellants seemingly maintain that a transfix member must be capable of performing transferring and fixing functions whereas Badesha '643 does not explicitly disclose that the denoted fuser device disclosed therein is capable of performing a transferring function in addition to the fixing (fusing) functions performed by a fuser. However, even if we could agree with Appellants that the name "transfix member" necessarily implies another functionality for the claimed device in addition to a fixing (fusing) function, Appellants have not fairly established that the substantially identical structure of the fuser of Badesha '643 would not be capable of performing the additional transfer functions of a transfix device.

¹ As we noted above, Appellants have brought this appeal on the basis of all of the appealed claims standing or falling together. Thus, we will not belabor the record with a discussion of the additional teachings of Swift or Badesha '504 as applied by the Examiner in combination with Badesha '643 to establish the obviousness of the other appealed claims.

In this regard, Appellants refer to a portion of pages 2 and 3 of their Specification in arguing that a transfix element “has different electrical, mechanical, and chemical requirements for the layers thereof” than those of a fuser (Br. 7-8, Reply Brs. 3). However, our review of the referred to pages of the Specification reveals no implicitly required product distinction for the claimed transfix member over the applied fuser of Badesha based on the general discussion about electrostatic printing machine transfer and transfix members set forth therein. Concerning the outer layer requirements of representative claim 20, we note that Badesha ‘643 discloses that the fuser members referred to therein employ an outer layer with good thermal properties that appears to be substantially identical to the outer layer required by the representative claim. Compare the mica-type layered silicate described for use in the silicone elastomer-containing outer layer of the fuser of Badesha ‘643 with the requirements of representative claim 20. *See, e.g.*, col. 6, l. 43 through col. 2, l. 52 of Badesha ‘643.

As our reviewing court stated in *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997):

A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971)(“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant

to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Here, we determine that the correspondence between the fuser structure of Badesha '643 and the structure required by representative appealed claim 20 furnishes sufficient reason to believe that the fuser of Badesha '643 possesses the functional limitation(s) that, from Appellants' perspective, would be required by the claimed appellation "transfix member." This is so since the structures of the claimed device and the applied fuser of Badesha '643, including the outer layer thereof, appear to be identical or substantially identical. Therefore, even if we could agree with Appellants that representative claim 20 requires a transfer functionality as argued, the burden would then shift to Appellants to show that the fuser of Badesha '643 does not possess the argued intrinsic functionally allegedly required of the claimed transfix member. Appellants, however, failed to carry this burden.

CONCLUSION

The decision of the Examiner to reject claims 1-10 and 13-21 under 35 U.S.C. § 103(a) as being unpatentable over Badesha '643 in view of Swift and to reject claims 1-17, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Badesha '643 in view of Badesha '504 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED

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